



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/716,843 | 11/19/2003 | Sanjay Patel | S1177/20047 | 7093 |
| 3000 | 7590 | 03/01/2006 | EXAMINER | |
| CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212 | | | WOODWARD, ANA LUCRECIA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |
| DATE MAILED: 03/01/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

5

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/716,843 | Applicant(s) PATEL, SANJAY | |
| | Examiner Ana L. Woodward | Art Unit 1711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/18/2004, 6/20/2005, 12/8/2005
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8-13, 21-23, 25-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 14-20 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/18/04, 6/20/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, drawn to a coating, classified in class 524, subclass various.
 - II. Claims 25-32, drawn to a coated article, classified in class 428, subclass various.
 - III. Claims 33-44, drawn to a process of coating, classified in class 427, subclass various.
 - IV. Claims 45-49, drawn to a process of making paper, classified in class 162, subclass various.

2. The inventions are independent or distinct, each from the other because:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as molding composition or in the production of self-supporting films and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

3. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as by extrusion coating.

Art Unit: 1711

4. Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process such as in the production of laminated products having different utilities.

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Art Unit: 1711

7. Applicant's election with traverse of Group I filed December 8, 2005 comprising as an ultimate species a composition comprising a secondary amine as the neutralizing agent, a functionalized siloxane as the directly linkable molecule and the PAA defined on pages 6 and 9 wherein X is either $-\text{C}(\text{CH}_3)_2-$ or $-\text{SO}_2-$ in the reply filed on December 8, 2005 is acknowledged. The requirement is still deemed proper and is therefore made FINAL.

8. Claims 3, 8-13, 21-23 and 25-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of composition or group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 8, 2005.

Claim Rejections - 35 USC § 112

9. Claims 1, 2, 4-7, 14-20 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the metes and bounds of the “directly linkable molecule...that is linkable to a carboxyl group” are indeterminate in scope. As presently recited, said component reads on component (1) because component (1) has carboxyl group links and on component (2) because component (2) is “linkable” to the carboxyl groups of the PAA.

In claim 2, the metes and bounds of the “two other molecules” are indeterminate in scope.

In claims 4, 16 and 19, “functionalized” is indefinite as to scope and meaning.

Art Unit: 1711

In claim 15, the metes and bounds of the “cross-linkable molecule” are indeterminate in scope. It is unclear if or how said other cross-linkable molecule distinguishes over the cross-linker or over components (1) and (2).

In claim 18, the abbreviation PAI is undefined.

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 4-7, 14-20 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,479,581 (Ireland et al).

Ireland et al disclose aqueous-based coating compositions comprising a product formed of the combination of a polyamide-amic acid (PAA) and a triamine. The polyamide-amic acids are described as having a high acid number (column 3, lines 3-7), thus reading on the presently claimed PAA. The triamine neutralizes the amic acid functionality (column 3, lines 46-50) and, as such, reads on the presently claimed neutralizing agent. Furthermore, given that the triamine links to the carboxyl groups of the PAA, such also reads on the “directly linkable molecule...that is linkable to a carboxyl group”.

Art Unit: 1711

The disclosure of the reference meets the requirements of the present claims with respect to the types of materials added. As presently recited, the “directly linkable molecule” does not distinguish over either the repeat units of the polyamide-amic acid or over the triamine. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

13. Claims 1, 4-7, 18-20 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 4,832,808 (Buchwalter).

Buchwalter discloses reaction products of a polyimide, reading on the presently claimed PAA and a polyamine, reading on the presently claimed neutralizing agent as well as on the “directly linkable molecule...that is linkable to a carboxyl group”. The polyamine employed contains only one reactive primary or secondary amino group that is available to react with the polyimide (column 4, lines 55-60). Aqueous emulsions of the amine-modified polyimide are obtained (column 5, lines 37-40).

The disclosure of the reference meets the requirements of the above-rejected claims with respect to the types of materials added. As presently recited, the “directly linkable molecule” does not distinguish over either the repeat units of the polyimide or over the polyamine. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

14. Claims 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,133,840 (Buchwalter et al).

Buchwalter et al disclose polyamic acids having carboxyl groups, reading on the presently claimed PAI, and their reaction with epoxy compounds, hydrazines and hydroxyl-

Art Unit: 1711

functional compounds, reading on the presently claimed "at least one molecule other than a PAA or a PAI".

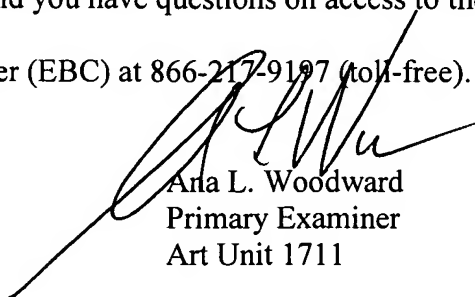
The disclosure of the reference meets the requirements of the above-rejected claims with respect to the types of materials added. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward
Primary Examiner
Art Unit 1711
